

Appl. No. 10/614,577
Petition to the Director dated July 29, 2004



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/614,577 Confirmation No.: 2594
Applicants : Kent Barker et al.
Title : ELECTRICAL CONNECTION APPARATUS AND
METHOD FOR AN AIRBAG INFLATOR
Filed : July 7, 2003
TC/A.U. : 2839
Examiner : Chandrika Prasad
Docket No. : 14254

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO THE DIRECTOR UNDER 37 CFR §1.144

Dear Sir:

This petition is submitted in regards to a species election requirement made by Examiner Chandrika Prasad for Serial No. 10/614,577. In accordance with 37 CFR §1.144, Applicants now petition the Director to review the election requirement and respectfully request vacatur of the same.

Statement of Facts:

On July 7, 2003, Kent Barker et al. (hereinafter "Applicants") filed a nonprovisional patent application for "Electrical Connection Apparatus and Method for an Airbag Inflator." In an Office Action dated June 9, 2004, Examiner Prasad required an election between fifteen different groups of species. *See* Exhibit A. Each group of species represents alternative, but closely-related features of the disclosed embodiments. Essentially, Examiner Prasad required an election between *any* Figure that disclosed an alternative embodiment of the present invention.

In accordance with 37 CFR §1.144, Applicants now petition the Director to review the election requirement and Applicants' arguments and respectfully request vacatur of Examiner's election requirement.

Arguments:

35 U.S.C. §121 provides that restriction may be required to one of two or more independent and distinct inventions. However, requiring Applicants to make multiple elections between fifteen different groups of species of closely related alternative embodiments of the claimed invention is inequitable in this situation for several reasons:

First, the election requirement is unduly burdensome on the Applicants. The Examiner has required Applicants to elect between fifteen different groups of species. Requiring an election between all fifteen groups of closely related subject matter requires Applicants to review in detail the specification and claims and identify all claims that read on each group of species. Essentially, the Examiner is shifting the burden of examination onto the Applicants. The Examiner has required an election between *any* alternative embodiment of the present invention. Such a requirement is overly restrictive and burdensome. The Examiner should not be permitted to shift the burden of examination upon the Applicants, when it can easily be examined at one time because of the relatedness of each disclosed alternative embodiment of the present invention.

Second, requiring an election between fifteen different groups of alternative features of the present invention may unnecessarily delay issuance of the claimed subject matter. If the Director does not vacate the Examiner's election requirement, the Examiner will only examine the elected claims first. Once those claims are in condition for allowance, the Examiner then determines if an allowable claim exists that is generic to the non-elected claims. 37 CFR §1.141. If a generic claim does exist, the Examiner then must perform another search as to the non-elected species. This process requires multiple analytical steps conducted at multiple stages, thereby prolonging the process of prosecution.

Third, the election requirement is inequitable because it may significantly increase the monetary burden on Applicants in prosecuting the claims. If after examining the elected species claims the Examiner finds no allowable generic claim, the non-elected species claims would only

be examined in a divisional application. Applicants would have to pay duplicate fees to prosecute divisional applications for the non-elected claims that are drawn to closely-related alternative embodiments of the claimed invention. Essentially, what could easily be handled in one case, the election requirement may eventually necessitate the payment of multiple filing, issuance, and maintenance fees due to the multiple elections required. It seems improper to pay multiple fees for closely related alternative embodiments of the claimed invention. Furthermore, Applicants would incur the additional costs of attorney preparation of responses and related correspondence for the prolonged prosecution process.

Fourth, compared to the cost, delay, and burden placed upon Applicants in prosecuting an application having fifteen different groups of species requiring an election, the additional burden on the Examiner in examining all claims at the same time is minimal to non-existent. The present application does not disclose an invention that is complex to search and examine. For example, the scope of the search necessitated in examining claim 1 is broad enough to encompass essentially each group of species identified by the Examiner. Examination of this application does not present the same burden on the Examiner as would a chemical application having hundreds of possible species. Consequently, the additional burden on the Examiner is minimal compared to the cost, delay, and burden on Applicants in maintaining the election requirement.

Moreover, the different groups of species disclosed are “related” to one another as per MPEP §806.04(b) and MPEP 806.05 *et seq.* Therefore, if the Examiner concludes they are distinct, the Examiner must show by appropriate explanation one of the following:

(A) Separate classification thereof: The Examiner must show that each distinct subject has attained recognition in the art as a separate subject for inventive effort and also requires a separate field of search.

(B) Separate status in the art if classified together: If each distinct subject is classified together, then the Examiner must show that each subject can be shown to have formed a separate subject for inventive effort. This may be shown by citing patents which are evidence of such separate status and also of a separate field of search.

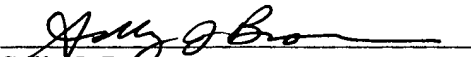
(C) A different field of search: The Examiner may show that it is necessary to search for one distinct subject in places where no pertinent art to the other subject exists.

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If the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, "no reasons exist for dividing among related inventions." MPEP §808.02.

For the foregoing reasons, Applicants respectfully request the Director to vacate the Examiner's election requirement in light of principles of equity and fairness. If there are any remaining issues that may be clarified by telephone, please call the undersigned.

Respectfully submitted,


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Date: July 28, 2004

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